

REMARKS

This application has been reviewed in light of the Office Action dated June 5, 2006. Claims 25-33 and 35 are presented for examination, of which Claim 25 is in independent form. Favorable reconsideration is requested.

Rejection

Claims 25-33 and 35 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,850,218 (LaJoie et al.) in view of U.S. Patent No. 5,488,427 (Kayashima et al.).

Interview Summary

Applicant gratefully acknowledges the courtesies extended by the Examiner during the interview conducted on September 19, 2006. In the interview, the allowability of Claim 25 with respect to the patents to LaJoie et al. and Kayashima et al. was discussed. The Examiner reiterated her rejection of Claim 25 over these patents.

Response to Rejection

This rejection is respectfully traversed for the following reasons. Claim 25 recites, in part, the step of displaying a setting screen for setting the duration of program information display for a second program. Therefore, under MPEP § 2142, to establish a prima facie case of obviousness, the Office has the burden of proving the obviousness of combining the patents to LaJoie et al. and Kayashima et al. to obtain the feature of displaying a

program-information-display-duration setting screen. But there is no disclosure in the LaJoie et al. and Kayashima et al. patents of a user-settable program-information-display duration or a program-information-display-duration setting screen, nor is there any suggestion or motivation that would lead one skilled in the art to combine these references in a manner that would achieve such a feature. The Office Action's stated motivation to add these features to the LaJoie et al. system — to improve the ease of use of the system for the novice by employing on-screen programming to set the program-information-display duration — assumes that this function is already being performed in a more cumbersome way. It is not. There is no disclosure or suggestion in either reference of a user setting a duration for display of program information, or of displaying a screen to allow a user to make such a setting. Hence, the proposed combination is based purely on a hindsight reconstruction of the claimed invention, using Applicants own claims to cobble together a patchwork of references to obtain a feature that neither reference discloses nor suggests, and which would not result from a natural combination of the teachings of these references.

Therefore, the motivation provided in the Office Action to combine the references to produce the claimed invention is unconvincing and does not satisfy MPEP § 2142. Accordingly, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness, as will now be discussed in more detail.

- A. The Patent Office bears the burden of proof to establish a prima facie case of obviousness against Claim 25 and has not satisfied that burden

MPEP § 2142 places the initial burden on the Office to factually support any prima facie conclusion of obviousness. Therefore, to reject Claim 25, the Office must allege facts showing

that the claimed method, including a step of displaying a setting screen for setting the duration of program information display, would have been obvious to one skilled in the art. And that factual burden must be satisfied without resort to Applicant's own disclosure:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the "differences," conduct the search and evaluate the "subject matter as a whole" of the invention. The tendency to resort to "hindsight" based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art. (MPEP § 2142)(emphasis added)

Thus, to reject Claim 25 for obviousness, the Office must rely on facts gleaned from the prior art to render this feature obvious. But the only document that discloses or suggests setting-screen display of the program-information-display duration is Applicants' own disclosure. The prior art is silent on this crucial fact. Instead, the LaJoie et al. patent teaches that "a program information banner . . . is preferably displayed for a fixed period of time (e.g. 2 seconds) or until an information key . . . is depressed . . ." (column 15, lines 19 - 27) (emphasis added). Therefore, this patent is not understood to disclose or suggest that a user can set a duration for displaying program information, and therefore does not disclose or suggest the display of a program-information-duration setting screen. And, Applicant submits that the Kayashima et al. patent does not even display a program information banner, let alone a way for the user to set the

program-information-banner-display duration, or a screen for setting the time period for displaying such a banner.

Since the crucial facts of allowing a user to set the program-information-display duration, and of displaying a setting screen for that purpose, are found only in Applicant's own disclosure, Applicant submits that the Office's conclusion of obviousness is based on impermissible hindsight in using Applicant's own disclosure to provide the suggestion to modify the references to produce the invention of Claim 25. Therefore, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness against Claim 25.

B. The Patent Office has not satisfied the three criteria for establishing prima facie case of obviousness against Claim 25 set forth in MPEP § 2142

1. The Office has not satisfied the all-limitations criteria

MPEP § 2142 requires the cited art to disclose or suggest *all* the claimed features. But here, neither the patent to LaJoie et al., nor the patent to Kayashima et al. discloses or suggests the step of displaying a setting screen for setting the duration of program information display, as recited by Claim 25. Rather, the LaJoie et al. patent teaches the display of a program information banner for a fixed time (e.g. 2 seconds) or until an information key is depressed, while the Kayashima et al. patent does not even teach the display of program information. Therefore, the all-limitations criteria of MPEP § 2142 has not been satisfied, and for this reason alone, the Office has not satisfied its burden of proof to establish a prima facie case of obviousness against Claim 25.

2. The Office has not satisfied the motivation-to-combine criteria

MPEP § 2142 also requires a legally sufficient motivation to combine the references to produce the claimed invention to support a prima facie case of obviousness:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references". Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144 - § 2144.09 for examples of reasoning supporting obviousness rejections

But here, the references do not expressly or impliedly suggest the claimed invention, and the Office Action's reasoning is unconvincing because it is based on a false assumption and unsupported by knowledge generally available to those skilled in the art, scientific principles, or legal precedent, as required by MPEP § 2144, as will be discussed below.

- a. The references fail to expressly or impliedly suggest the program-information-duration, setting-screen display step

The Office Action does not rely on the LaJoie et al. patent, or the patent to Kayashima et al. to suggest the step of displaying a setting screen for setting the duration of program information display, as recited by Claim 25. Rather, page 3 of the Office Action admits that the LaJoie et al. patent "explicitly [does] not disclose the newly added claimed [sic] that the displaying a setting screen sets the duration of program information display. . .", and cites the Kayashima et al. patent to show "a television setting menu screen having [a] timer having five

durations to be set by the user. . . .”. The Office Action never identifies the function of the timer and never asserts that this patent discloses the displaying of a screen for setting the duration of program information display, as recited by Claim 25. Moreover, the patent itself also does not identify the function of this timer. The only description of this figure, at column 7, line 12, states “FIG. 21 shows a television setting menu screen”. There is no disclosure or suggestion that the timer relates to a display duration.

Thus, the cited art is not understood to disclose or suggest the claimed program-information-display setting screen, nor does the Office Action assert that it does. Therefore, the Office Action cannot rely on the explicit or implicit disclosures of the applied art to support its motivation-to-combine argument.

- b. The Office fails to provide a convincing line of reasoning to combine the references based on generally available knowledge, established scientific principles, or legal precedent

If the references themselves do not supply the rationale for the claimed combination, MPEP § 2144 requires the Examiner to provide a convincing line of reasoning, based on knowledge generally available to those skilled in the art, established scientific principles, or legal precedent established by case law. But the Office Action fails to provide such reasoning and such reasoning, as can be seen from this excerpt from page 3 of the Office Action:

Therefore, it would have been obvious to one [of] ordinary skill in the art at the time of the invention to incorporate the timer setting as taught by Kayashima et al into LaJoie et al’s system in order to allow the user to easily manipulate the device even [if] the user [is] unfamiliar with the operation of the device.

This passage posits that the skilled artisan would be motivated to combine the teachings of the patents to Kayashima et al. and LaJoie et al. to produce the claimed invention because to do so would make it easier for the unfamiliar user to manipulate the device. Such a rationale is discussed at column 6, lines 33-35 of the Kayashima et al. patent. In that patent, the inventors propose to replace a complex remote control, which operates a television system comprising a VCR, a disc layer, a tape deck, a radio tuner, and a television set, with on-screen programming. The patent explicitly states that on-screen programming is easier for the novice to use than a complicated remote control. But this reasoning cannot be applied to the addition of a program-information-duration setting screen to the LaJoie et al. patent for four reasons.

First, adding a program-information-duration setting screen to the LaJoie et al. patent *complicates* LaJoie et al.'s program guide because the LaJoie et al. patent *does not permit the user to set the duration of program information display*. Adding such control adds to the complexity of the program guide, adds to the complexity of the user interface, and adds to the complexity of the user experience. Thus, the Office Action's rationale is factually incorrect.

Second, to use Kayashima et al.'s on-screen-programming rationale in this case to increase the ease of use presupposes that it is already known for the user to select the program information duration by some method more complicated than on-screen programming. Otherwise, it would not be easier for the user to manipulate the program information display duration by using on-screen programming. *But this assumption is false.* There is no evidence of record that the art discloses the user setting of the program information duration.

Third, the Office Action fails to establish that knowledge generally available to the skilled artisan or established scientific principles teach the use of a program-information-duration setting screen for user selection of the program information duration.

Fourth, the Office Action cites no legal precedent from which to argue that obviousness of adding a program-information-duration setting screen to the LaJoie et al. patent.

Thus, under MPEP § 2144, the Office has not established a legally sufficient motivation to combine the art to produce the invention of Claim 25.

3. The Office has not satisfied the reasonable-expectation-of-success criterion

MPEP § 2142 further requires that there be a reasonable expectation of success when modifying the art to produce the claimed invention and that “the reasonable expectation of success must . . . be found in the prior art, and not based on applicant’s disclosure”. But here, since the patents to Kayashima et al. and LaJoie et al. do not disclose or suggest a program-information-duration setting screen for user selection of the program information duration, as recited by Claim 25, there can be no reasonable expectation of success that is “found in the prior art”. Therefore, the Office has not satisfied its burden of proof under MPEP § 2142 to establish a reasonable expectation of success.

For all of these reasons, Applicants respectfully request that the outstanding rejection of Claim 25 be withdrawn.

The other rejected claims in this application depend from one or another of the independent claim discussed above and, therefore, are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the

invention, individual consideration or reconsideration, as the case may be, of the patentability of each claim on its own merits is respectfully requested.

Conclusion

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and early passage to issue of the present application.

Applicant's undersigned attorney may be reached in our Washington D.C. Office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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